

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Yamamoto et al.
Appl. No.	:	10/618,957
Filed	:	July 14, 2003
For	:	SURFACE PROTECTIVE FILM FOR TRANSPARENT CONDUCTIVE SUBSTRATE, AND TRANSPARENT CONDUCTIVE SUBSTRATE WITH SURFACE PROTECTIVE FILM
Examiner	:	Chang, Victor S
Group Art Unit	:	1794

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the rejections of the claim in the non-final Office Action of December 18, 2008 for the above-identified application. No amendments are being filed with this request.

Enclosed with this Request is a Notice of Appeal.

REASONS FOR REQUEST

Review of the above-identified application is requested for the following reasons:

There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. §102(a)

Claims 8, 10-12, 14 and 18 are rejected under 35 U.S.C. §102(a) as being anticipated by Masuda (U.S. Publication No. 2002/0064650). The Examiner asserts that Masuda's paragraph [0044] necessarily discloses Applicants' claimed film.

The Examiner's rejection contains clear error because the Examiner fails to establish that Masuda discloses, expressly or inherently, all elements of the claim. Specifically, the Examiner

Appl. No. : **10/618,957**
Filed : **July 14, 2003**

fails to establish that Masuda discloses a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film.

Masuda discloses a film for window application comprising a polyester film and an antistatic coating on at least one of its external layers. *Masuda* at Abstract and paragraph [0027]. Masuda teaches that in one embodiment, the film also contains a hard coating. *Masuda* at paragraph [0013]. Masuda teaches that a film containing the hard coat can also contain an adhesive applied to the side opposite from the hard coat. *Masuda* at paragraph [0044]. Masuda teaches the adhesive is applied in the same way as the hard coat is applied. *Id.* All of Masuda's examples have an antistatic coating on both sides of the film, with a hard coat and an adhesive respectively applied to the two antistatic coatings. *Masuda* at paragraphs [0081] and [0099].

Masuda does not disclose a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film. The Examiner's argument to the contrary is clearly erroneous. Those skilled in the art are aware of any of a number of layers, such as a polarizing, dye-containing layer or additional hard coat layer, that also could be placed between the adhesive layer and the base film. As such, those skilled in the art would know that nothing in Masuda's paragraph [0044] or elsewhere, would require that an adhesive layer must necessarily be formed on and in contact with one side of the base material film.

The Examiner argues that he sees no interpretation of Masuda's paragraph [0044] other than forming an adhesive layer on and in contact with one side of the base material film when the antistatic coating is applied only on one side of the film. *Office Action* at page 5. He appears to interpret this paragraph as stating that there are embodiments in which an adhesive layer is present without an antistatic coating on the same side, and in such instances, the adhesive layer would necessarily contact the base film. However, the Examiner erroneously distorts Masuda's teachings in order to arrive at this conclusion.

Masuda provides three of four embodiments in which no hard coat or adhesive is identified as being present, and, in the fourth embodiment, a hard coat, but no adhesive, is identified as being present. *See Masuda* at paragraphs [0010]-[0013] and claims. Thus, the hard coat is optional component present in some of Masuda's films, and the adhesive layer is an optional component present in some of Masuda's hard coat-containing films. Masuda appears to indicate that the presence of both the optional hard coat and optional adhesive layer is preferred.

Appl. No. : **10/618,957**
Filed : **July 14, 2003**

Masuda at paragraph [0052] and Examples. Whenever an optional layer (*e.g.*, hard coat or adhesive) is present, the optional layer is applied on top of the antistatic layer in order to provide at least the advantage of eliminating nonuniformity in such optional layers. *Masuda* at paragraphs [0040], [0044], [0099], [0108], [0110], [0123], [0124] and Table 1. *Masuda* provides no embodiment of *Masuda*'s invention in which one of the optional layers is present in the absence of an underlying antistatic layer. Thus, *Masuda* teaches that when the preferable, but optional, adhesive layer is present, an antistatic coating is provided between the base film and the optional adhesive layer. Therefore, *Masuda* at paragraph [0044] is properly interpreted as stating that since it is preferable for *Masuda* to provide a hard coat and adhesive layer, it also is preferable for *Masuda* to provide antistatic coating on both sides of the film. It would be inconsistent with *Masuda*'s general teachings, Examples, and results in Table 1 to interpret *Masuda* as teaching that when the optional adhesive layer is present, an antistatic coating is not be placed between the adhesive layer and the base film. As such, the Examiner's interpretation of paragraph [0044] is clearly not necessitated by the teachings of *Masuda*.

In view of the above, *Masuda* fails to show the identical invention in as complete detail as is contained in Applicants' claims as required by M.P.E.P. §2131 and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Accordingly, the Examiner's anticipation rejection of the claims is clearly erroneous.

There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. §§102(a)/103

Claim 19 is rejected under 35 U.S.C. §102(a) as being anticipated by, or, in the alternative, under 35 U.S.C. §103 as being obvious over, *Masuda*. The Examiner points to paragraphs [0102]-[0103] in asserting that *Masuda* teaches an adhesive that either inherently possesses the recited monomers, or is obviously provided by practicing the invention of *Masuda* for the same end use.

The Examiner's rejection contains clear error because the Examiner fails to establish that *Masuda* inherently discloses, or renders obvious, all elements of the claim. Specifically, *Masuda* does not disclose or teach the monomer composition of the adhesive layer recited in Claim 19.

The adhesive composition relied on by the Examiner is never used in a film in accordance with *Masuda*'s invention and is never used in a film which contains all elements of Claim 19. The Examiner relies on adhesive coatings used only in *Masuda*'s Comparative Examples, which (a) do not contain an antistatic layer, and (b) *Masuda* teaches possess undesirable properties

Appl. No. : **10/618,957**
Filed : **July 14, 2003**

inferior to the films of Masuda's invention. Masuda does not teach that the adhesive films relied on by the Examiner can be used in the adhesive layer in accordance with Masuda's invention. The only specific adhesive provided by Masuda in the adhesive layer of Masuda's invention is an adhesive layer formed from a 40% polybutyl acrylate solution. *Masuda* at paragraph [0099].

Claim 19 is directed an adhesive layer comprising a co-polymer containing 0.1 through 12 percent by weight of monomers having functional groups selected from carboxyl groups, hydroxyl groups, epoxy groups and amino groups. A polybutyl acrylate adhesive layer does not inherently possess the elements of Claim 19. Accordingly Masuda cannot anticipate Claim 19. Therefore, the Examiner's anticipation rejection is clearly erroneous.

The Examiner asserts that the claimed adhesive is obviously provided by practicing the invention of Masuda for the same end use. However, Masuda's adhesive layer of paragraphs [0102]-[0103] is used only in undesirably inferior films. Masuda does not teach using this composition as the adhesive layer of Masuda's invention. If anything, these teachings would lead one of ordinary skill away from using such an adhesive layer. Further, there is no evidence that the claimed adhesive is an obvious variant of Masuda's polybutyl acrylate adhesive because there is no teaching that polybutyl acrylate can be modified to contain additional components such as that which Applicants claim. Moreover, Applicants' adhesive is not applied to the "same end use" as Masuda's adhesive. Masuda is directed to films applied to automobile and architectural structure glass. *Masuda* at paragraph [0001]. In contrast, Applicants' claimed film finds particular applicability when used with a transparent conductive substrate, particularly when processed at elevated temperatures. *Specification* at page 3, second full paragraph. These uses do not represent the "same end use." As such, the Examiner's assertions of obviousness are unsupported by the evidence. Therefore, the Examiner's obviousness rejection is clearly erroneous.

There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. §103

Claims 15 and 20 are rejected under 35 U.S.C. §103 as being obvious over admitted prior art and Masuda. The Examiner argues that the application admits that two-layered protective films are known and that PET has been used in heat-resistant protective films. The Examiner states that it would have been obvious to add the antistatic layer and adhesive layer of Masuda to the films of the admitted prior art.

Appl. No. : **10/618,957**
Filed : **July 14, 2003**

The Examiner's rejections of Claims 15 and 20 are clearly erroneous because each rejection requires ignoring clear teachings of Masuda that would lead away from the claims.

Regarding Claim 15, as discussed above, Masuda teaches that the antistatic layer is used, at least in part, to reduce nonuniformity of the layer placed over the antistatic layer. As such, when Masuda's adhesive layer is used, Masuda teaches the desirability of first applying an antistatic layer. Thus, it would make no sense under Masuda's teachings to apply an antistatic layer on one side of a base film while applying the antistatic layer on the other side. Moreover, Masuda provides no embodiments in which a hard coat layer is absent and an adhesive layer is present. In order to arrive at the structure of Claim 15, one of ordinary skill must carefully ignore selected teachings of Masuda that otherwise would lead away from the claimed structure. There is no basis in Masuda for such selective picking and choosing. Accordingly, the Examiner's failure to consider Masuda's teachings as a whole, including the teachings that would lead away from the claimed invention, is clearly erroneous.

Regarding Claim 20, Masuda specifically teaches the undesirability of a single-layer film, and that one key to Masuda's invention is the avoidance of such a single layer film. *Masuda* at paragraphs [0016] and [0017]. As such, Masuda clearly teaches away from a single-layer film. In order to arrive at the structure of Claim 20, one of ordinary skill must proceed contrary to the teachings of Masuda. Accordingly, the Examiner's failure to consider Masuda's teachings away from the invention of Claim 20 is clearly erroneous.

CONCLUSION

The rejection of the claims is clearly erroneous and must be reversed. Accordingly, the claims are in condition for allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 17, 2009

By: /Kerry Taylor/

Kerry Taylor
Registration No. 43,947
Attorney of Record
Customer No. 20,995
(619) 235-8550